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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/655,826

09/05/2003

Steven Kaufmann

7148

37476 7590 02/07/2008  
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EXAMINER

THOMASSON, MEAGAN J

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

02/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/655,826	<b>Applicant(s)</b> KAUFMANN, STEVEN	
	<b>Examiner</b> Meagan Thomasson	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-13 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 2-13 and 15-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

The examiner acknowledges the amendments made to claims 2-4,6,9,11-13 and 18. Claims 1,14 and 19 are canceled.

### *Claim Objections*

Claims 2-13 and 15-18 are objected to because of the following informalities:  
Claim 2 contains previously presented claim limitations that are marked by underlining, indicating that the limitations are newly added to the amended claim. This is improper, as all previously presented limitations should not be marked.

Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment

document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) **When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims.** The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) **When claim text in clean version is required.** The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) **When claim text shall not be presented; canceling a claim.**

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) **Reinstatement of previously canceled claim.** A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

Emphasis has been added to the relevant passage outlining this requirement.

Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 2-13 and 15-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1. Claim 2, lines 19-20 (P.2 of claim amendments) recite "the personal database provides no pre-selected words and phrases that a tutor has may have prepared for the learner". There is no support for this negative limitation in applicant's specification, as the specification as originally filed does not recite what the personal database does not store.

2. Claim 2, lines 12-14 (P.3 of claim amendments) recite "providing no direct feedback form a tutor during the learning activities and said tutors of overseeing the learners' activities occasionally and providing encouragement and social interaction to the learners". There is no support in applicant's specification as originally filed for the negative limitation of what the tutors, referred to on P. 7 of applicant's specification as "language coaches", do **not** do. In fact, applicant's specification specifically discloses that a language coach provides "writing correction and analysis by their coach" as well as "a weekly report created by the coach detailing and analyzing the learner's progress" (P. 7, 3<sup>rd</sup> paragraph). From this, it is clear that the tutors do in fact provide direct

feedback during learning activities in the form of writing correction and analysis as well as reports detailing the progress of a learner. Further, a tutor providing "encouragement" and "overseeing the learner's activity" is a form of providing direct feedback to a learner.

3. Claim 2, lines 21-22 (P. 2) recite "the learner is able to use the personal database as a means for collecting all terms ... no matter where or how he encounters them". There is insufficient support for this limitation in applicant's specification, as the specification merely recites allowing the user to "vary their reading by using the well known computer cut and paste method to insert or import outside content into the workdesk" (Specification, P. 6). This implies that a user may import text from outside sources, but not that a user may import all terms "no matter where or how he encounters them". For instance, a user may not import terms heard during a live conversation using a computer cut and paste method and therefore the limitation of collecting terms "no matter where or how he encounters them" is not expressly, implicitly or inherently supported in the originally filed disclosure.

4. Claim 4, line 9 recites "specifically providing no means for computer checking of the learners text". There is no support in applicant's specification as originally filed for this negative limitation. See MPEP §2173.05(i) regarding negative claim limitations.

5. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for allowing the user to "vary their reading by using the well known computer cut and paste method to insert or import outside content into the workdesk" (Specification, P. 6), does not reasonably provide enablement for "the

learner is able to use the personal database as a means for collecting all terms ... no matter where or how he encounters them". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification implies that a user may import text from outside electronic document sources using cut and paste methods, but not that a user may import all terms "no matter where or how he encounters them". For instance, a user may not import terms heard during a live conversation or from reading a hard copy document using a computer cut and paste method and therefore the limitation of collecting terms "no matter where or how he encounters them" is not enabled in the originally filed disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 2-13 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

5. The claims contain multiple grammatically awkward or incorrect limitations that make it difficult to understand the subject matter being claimed. For instance, in claim 2:

- Line 10 (P. 2) recites "displaying to learner a control panel". The term "learner" is not previously recited in the claim.

- Line 12 (P. 2) similarly recites the limitation "learner engaging in a selected instruction section" without any indication of who "learner" is. Is it a learner, any learner, the learner?
- Lines 19-20 (P. 2) recite "the personal database provides no preselected words and phrases that a tutor has may have prepared for the learner".
- Line 23 (P. 2) recites "a central database of all a lerner's language learning activities".
- Lines 1-2 (P. 3) recite "tracking and measuring all the learner's activities ... and uses this information to set goals". It is not clear who or what uses this information.
- Line 6 (P. 3) recites "...comparing the words in a new item with the database of known words" without providing any indication of what an "item" is.
- Lines 13-14 (P. 3) recite: "... and said tutors of overseeing the learner's activities occasionally and providing encouragement".

In claim 18:

- Lines 14-16 recite: "providing correction means for correcting essays; learner's text input for proper syntax". This is grammatically awkward.
- Line 17 recites: "a tutor reads the submissions, identify what the learner is trying to say". This is grammatically awkward.



6. Claims 3 and 4 contain contradicting limitations, and thus render the claims indefinite. Claim 3 recites "writing correction which provides that a learner submitting any text that he has written is first analyzed by a tutor **and then corrected using the personal database**" (emphasis added). Claim 4, which depends from claim 3, recites "the language instruction sessions include the submission of written text samples .... for review and **specifically providing no means for computer checking of the learners text**". This is in direct contrast to the limitations of claim 3, wherein the personal database corrects a writing sample and is clearly a means for computer checking.

7. Claims 2, 3 and 18 similarly contain contradicting limitations about the role of the tutor in correction of the learner's text samples. Claim 2 recites "providing no direct feedback from a tutor during the learning activities", and claim 18 recites "a tutor reads the submissions, identify what the learner is trying to say, replace the learner's incorrect phrasing with correct, natural phrasing and then provide specific feedback to the types of mistakes being made". Clearly, the tutor provides feedback during the learning activities.

### ***Response to Arguments***

The number of 35 U.S.C. 112 rejections render the claims difficult to interpret, and the examiner requests that applicants review the claim language carefully in order to more clearly claim their invention. The withdrawal of the prior art rejections in this action is due to the difficulty of interpretation and not an indication of the claims being patentable over the prior art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Meagan Thomasson  
January 24, 2008

  
XUAN M. THAI  
SUPERVISORY PATENT EXAMINER